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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,030	05/02/2006	Paul Nicholas Roger Isaacs	1031-003	8329

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WITHROW & TERRANOVA, P.L.L.C.
100 REGENCY FOREST DRIVE
SUITE 160
CARY, NC 27518

EXAMINER

BOSWELL, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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3676

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/578,030

Applicant(s)

ISAACS, PAUL NICHOLAS
ROGER

Examiner

Christopher Boswell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/2/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

Applicant is advised that should claim 12 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 7-8, 11-15 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,246,258 to Kerschenbaum et al.

Kerschenbaum et al. discloses a lock (10') comprising a lock mechanism (28b) arranged to receive and lock to an associated keep (120), characterised in that the lock comprises an outer cover (12) which extends over both the lock mechanism and the keep when the keep is locked to the lock and in that the cover prevents access to both the lock mechanism and the keep (figures 9-15), as in claim 1.

Kerschenbaum et al. also discloses the components of the lock mechanism which retain

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the keep in a locked position within the lock are located within the lock (figures 9-15) and the lock cover is profiled such that a cutting/grinding disk extending in excess of 20 mm from the body of a cutter would be required to sever those components and release the keep (the cover has a defined void within the extents for containing the components of the lock, wherein a cutting device would have difficulty reaching these components), as in claim 2.

Kerschenbaum et al. further discloses the cover protects the lock from the weather (the cover encases the components, and thus protects them from environmental conditions), as in claim 7, and the lock mechanism comprises electronic circuitry (the circuitry that drives the solenoid 18) and mechanical elements (59b and 80b) controlled by the electronic circuitry, as in claim 8, as well as the electronic circuitry (10) controls an actuator (18) which releases the mechanical mechanism, as in claim 14, and where the actuator is a piezoelectric actuator (column 6, lines 6-30), as in claim 15.

Kerschenbaum et al. additionally discloses a mechanical linkage (101a and 126) extends through the cover of the lock such that the linkage can be activated by a user (via key cylinder 101), wherein the lock is arranged such that on receipt of a correct code or signal, the electronic circuit enables the lock to be released by the user operating the mechanical linkage such that the energy required to lock or release the lock is supplied by the user (via rotational movement of the key cylinder), as in claim 11, wherein the circuitry comprises a wake up mode which is activated by the user operating the mechanical linkage (column 10, line 7-column 11, line 17), as in claims 12 and 20, as well as the mechanical linkage comprising a cylinder lock (101) arranged to release the lock manually when operated by the correct key, as in claim 13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerschenbaum et al., as applied above.

Kerschenbaum et al. discloses the claimed invention except for the material that the cover is manufactured from. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a material for the cover that would be resistant to tampering and unauthorized access to the components of the lock, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Also it is common knowledge to those of ordinary skill to choose a material that has sufficient strength for the intended use of that material.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerschenbaum et al., as applied above, in view of U.S. Patent Number 4,509,350 to Gartner.

Kerschenbaum et al. discloses the invention substantially as claimed. However, Kerschenbaum et al. does not disclose of inserts being attached to the cover. Gartner teaches of a locking assembly that has a protective cover (30) that has a plurality of inserts (41-47) applied

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in a concentric pattern (figures 2 and 3), wherein the inserts are made from a non-drillable material such as a hard carbide material (hardened steel) or ceramic (column 3, lines 16-33) in the analogous art of secure locking assemblies that are mounted on the exterior of a door for the purpose of providing protective means for preventing and impeding the unauthorized intrusion into the lock as by drilling through a safe door. It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate protective inserts, manufactured from hardened steel or ceramic, as taught by Gartner, into the cover of Kerschenbaum et al. by milling grooves therein and braising the inserts securely within the grooves in order to provide a protective means for preventing and impeding the unauthorized intrusion into the lock as by drilling through the cover.

Claims 9-10 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerschenbaum et al., as applied above, in view of U.S. Patent Number 7,073,357 to Nixon, Jr.

Kerschenbaum et al. discloses the invention substantially as claimed. However, Kerschenbaum et al. does not explicitly disclose the electronic circuitry having a keypad or a receiver to permit operation of the lock mechanism. Nixon, Jr. teaches a lock mechanism () that has electronic circuitry (30) and mechanical elements (28) the circuitry comprises a keypad (110) aligned with an aperture (via element 106) in a cover (46) permitting the lock to be operated when a correct code is entered on the keypad (column 4, lines 23-40), as in claim 9, and a receiver (processor of element 30; column 4, lines 23-40) for receiving a signal externally of the cover (via element 110) and permits operation of the lock when an authorization signal is received, as in claims 10 and 17, in the analogous art of electrically operated locking

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mechanisms for the purpose of having an unlocking means available to a user such that a key or other additional devices are not necessary to actuate the lock. It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a keypad and a receiver, as taught by Nixon, Jr., into the lock of Kerschenbaum et al. by applying the keypad external to the cover and capable of sending a signal to a receiver within the cover to actuate the solenoid in order to have an unlocking means available to a user such that a key or other additional devices are not necessary to actuate the lock.

Kerschenbaum et al. also discloses a mechanical linkage (101a and 126) extends through the cover of the lock such that the linkage can be activated by a user (via key cylinder 101), wherein the lock is arranged such that on receipt of a correct code or signal, the electronic circuit enables the lock to be released by the user operating the mechanical linkage such that the energy required to lock or release the lock is supplied by the user (via rotational movement of the key cylinder), as in claims 18 and 19.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to electromechanical locking devices:

U.S. Patent Number 7,302,418 to Martin et al., U.S. Patent Number 7,017,379 to Hsieh, U.S. Patent Number 6,644,072 to Hsieh, U.S. Patent Number 6,486,793 to Buccola, U.S. Patent Number 6,035,676 to Hudspeth, U.S. Patent Number 5,626,039 to Solari et al., U.S. Patent Number 4,917,419 to Mora, Jr. et al., U.S. Patent Application Publication Number 2005/0144991 to Bravo et al.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Boswell whose telephone number is (571) 272-7054. The examiner can normally be reached on 9:00 - 4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher Boswell
Examiner
Art Unit 3676


Suzanne Dino Barrett
Primary Examiner

CJB 
March 16, 2007